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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,975	10/28/2003	Lang H. Nguyen	03089	4434
65672	7590	04/02/2010		
LAW DEPARTMENT CABOT CORPORATION 157 CONCORD ROAD BILLERICA, MA 01821			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			04/02/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/694,975

Applicant(s)

NGUYEN, LANG H.

Examiner

MICHAEL M. BERNSTEYN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24-35 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24-35 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action follows a response filed on February 2, 2010. No new claims have been added or amended; claims 1, 3-6, 10-12 and 18-21 have been cancelled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 2, 2010 has been entered.
3. Claims 22, 24-35 and 27-41 are pending.

Claim Rejections - 35 USC § 103

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 22, 24-35 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U. S. Patent Application Publication 2003/0191231, now U. S. Patent 7,022,759) in view of Belmont (U. S. Patent 5,672,198), for the rationale recited in paragraph 9 of the Office Action dated December 3, 2008, and comments below.

Response to Arguments

6. Applicant's arguments filed on February 2, 2010 have been fully considered but they are not persuasive.
7. It appears that the focal Applicants argument resides in the contention that while Martin discloses polyester oligomers that may include polyethylene oxide compounds, applicants fail to see where Martin discloses a non-ionic surfactant that is a polyalkylene oxide that is insoluble in water. Therefore Martin fails to disclose each and every limitation recited in claims 22 and 31. Even if the combination of Martin and Belmont is proper, the addition of Belmont fails to cure this deficiency (page 6, 2nd paragraph).
8. It is noted that Martin discloses that surfactants and or high shear can be utilized in order to assist in the dispersion of the polyester oligomer(s) in water (even if the oligomer(s) is self-dispersible). Suitable surfactants include but are not limited to conventional anionic, cationic and/or non-ionic. Non-ionic surfactants include polyglycol ether compounds and polyethylene oxide compounds (page 7, [0085]). Also Martin discloses NeoCryl BT-24 (acrylic emulsion polymer) (page 15, [0197]), which is exemplified in the specification (Example 1, page 13).
9. In response to applicant's argument that there is no suggestion to combine the references (pages 6-7), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the pigment which is a modified carbon product comprising a carbon product having attached at least one organic group as taught by Belmont in Martin's aqueous polymeric composition because in contrast to conventional carbon pigments, the modified carbon products for use in the ink or coating of the present invention are not difficult to disperse in an aqueous vehicle. The modified carbon products do not necessarily require a conventional milling process, nor are dispersants necessarily needed to attain a usable ink or coating. Preferably, the modified carbon products only require low shear stirring or mixing to readily disperse the pigment in water (US'198, col. 3, lines 19-27), and thus to arrive at the subject matter of instant claims 22-27, 31 and 37-41.

It is further noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

10. In response to applicant's argument that Belmont's reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Belmont discloses aqueous ink compositions which include a modified carbon product comprising a carbon having attached at least one organic group that is substituted with an ionic or an ionizable group. A coating composition is also described and comprises water, a binder, and a modified carbon product having at least one organic group attached to carbon wherein the organic group is substituted with an ionic or an ionizable group (abstract, col. 2, lines 44-47).

11. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 7, 2nd paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796